

Appl. No. 09/954,874
Amdt. dated June 24, 2005
Reply to Office Action of March 25, 2005

RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
TC/A.U. 1771

REMARKS/ARGUMENTS

Claims 17-28 and 30-44 are presented for Examiner Salvatore's consideration. Claims 1-16 and 46-47 are previously withdrawn as non-elected claims, and claims 29 and 45 are previously canceled. Claims 17 and 37 are shown as currently amended on the attached listing of claims. Claim 17 is amended to clarify terminology and claim 37 is amended to correct an error of grammatical nature.

Pursuant to 37 C.F.R. § 1.116, reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

By way of the Office Action mailed March 25, 2005, the Examiner maintained rejection of claims 17-28 and 30-44 under 35 U.S.C. § 103(a) as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Patent Number 6,186,320 to Drew (hereinafter "Drew") in view of U.S. Patent Number 5,709,735 to Midkiff et al. (hereinafter "Midkiff et al."). This rejection is respectfully **traversed** to the extent that it may apply to the currently presented claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. Applicants submit that a *prima facie* case of obviousness has not been established both because, as described below, there is no motivation to combine the cited references, and because the cited references, even if combined, fail to teach or suggest at least two of the claims limitations.

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1. There is no proper motivation to combine the references

As the Examiner has noted, Drew teaches a double sided storage sleeve comprising a flexible first sheet, a flexible third sheet, and a flexible nonwoven, non-laminated second sheet positioned between the first and third flexible sheets. In addition, as the Examiner has noted, Midkiff et al. teach a high stiffness nonwoven filter medium. The Examiner has combined Drew and Midkiff et al. and again the Applicants reiterate their assertion that that one skilled in the art would not be motivated to make such a combination. The Examiner has stated that one skilled in the art would be motivated to do so by the desire to provide a storage sleeve having sufficient structural integrity. However, the Examiner has not shown why she believes the structural integrity of the Drew storage sleeve to be insufficient, or where, in the teachings of the references, one skilled in the art would find such insufficiency of structural integrity. The Examiner did argue in the Office Action mailed March 25, 2005 that "the flexible storage sleeve of Drew must have some minimum degree of stiffness or it would lack sufficient structural integrity to function as a storage sleeve". Applicants respectfully submit that this argument appears to incorrectly pit flexibility against structural integrity as if good structural integrity and high flexibility cannot exist together in the same material. Applicants submit that this is not the case. Please consider, for example, silk fabric that is used in a silk blouse. The silk blouse is made from pieces of extremely flexible material, yet is at the same time made from a fabric also having superior strength. And the blouse, once the pieces of silk are sewn together, has very good structural integrity, yet overall, the silk blouse is also very flexible and drapable. Therefore, Applicants respectfully submit that contravening the required flexibility taught by Drew, ostensibly to produce sufficient structural integrity, fails to provide proper motivation for such a combination.

In addition, Applicants again also submit that no proper motivation has been shown because one skilled in the art would be led away from, not toward, replacing the flexible nonwoven of Drew with a high stiffness nonwoven. These two concepts are at opposite ends of a spectrum, and therefore one skilled in the art would not be lead to search out a high stiffness material as a substitute where a flexible material was specified (nor, for example, to reach for a flexible material as a substitute where a high stiffness material was

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specified). The Examiner has again asserted that Midkiff et al. teach employing the nonwoven (i.e., the high stiffness nonwoven filter medium taught therein) for other low stiffness applications such as towels. Applicants again respectfully submit that this statement is simply not a correct characterization of the teaching of Midkiff et al.

The section of Midkiff et al. mentioning towels and relied upon by the Examiner is the Background section describing a generally known use for generally known nonwovens (Midkiff et al. at Col. 1 lines 15-19). Midkiff et al. do not in any way appear to suggest that their high stiffness nonwoven filter medium could be used as a towel. Furthermore, the Examiner is not combining the flexible sleeve of Drew with a general nonwoven mentioned in the Background of Midkiff et al. (one that might be expected to vary in flexibility depending on end use). The Examiner is attempting to combine the nonwoven as taught in Midkiff et al. with Drew for the purpose of arranging a combination that teaches elements of the Applicants' claims. Therefore, Applicants submit that it is highly improper to select from Midkiff et al., on the one hand and for purposes of collecting features relating to Applicants' claims, those elements taught by Midkiff et al. to make a high stiffness nonwoven, but yet on the other hand, state that the Midkiff et al. nonwoven might not actually be stiff because a more general nonwoven as mentioned in the Background could be used as a towel.

2. The proposed combination fails to teach all the elements of Applicants' claims

In any event, Applicants respectfully submit that, aside from lack of proper motivation to combine, even when combined together these references have not been shown to teach or disclose all of the parameters of Applicants' invention as presently claimed in claims 17-28 and 30-44.

The invention as presently claimed in amended claim 17 is directed to a storage sleeve for holding an article having a sensitive surface to protect the sensitive surface from damage. The storage sleeve comprises a first web having a top edge, a bottom edge and two side edges and, a second web comprising a nonwoven web comprising multicomponent thermoplastic polymer filaments bonded in a pattern unbonded bond pattern having

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continuous bonded areas defining a plurality of discrete unbonded areas, the nonwoven web having a bulk density in the range of about 0.075 g/cc to about 0.130 g/cc and a Gurley stiffness greater than about 80 mg and having a top edge, a bottom edge and two side edges, and wherein the first web is interconnected with the second web at or near the bottom edge and two side edges of the first web to form a pocket to hold said article having a sensitive surface.

Applicants submit that even if one skilled in the art were to replace the flexible second sheet of Drew with the high stiffness nonwoven of Midkiff et al., such a combination still fails to teach or suggest each and every element of the Applicants' claims, first by failing to teach the element of the nonwoven web having a bulk density in the range of about 0.075 g/cc to about 0.130 g/cc, and second by failing to teach the element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas.

First, regarding the bulk density limitation in claim 17, the Examiner has cited *In re Boesch*, 617 F.2d 272, 276; 205 USPQ 215, 219 (CCPA 1980) to support the argument that the bulk density, although not stated in the references, is a result effective variable within the skill of the art to optimize to such a range as that recited by Applicants' claims. However, the rule recited in *In re Boesch* applies where such a variable that is optimized is recognized to be a result effective variable. Please see M.P.E.P. 2144.05(II)(B) citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (Cust. & Pat.App.1977) ("A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation."). Here, Applicants have not carved out some narrower range from within some larger or overlapping range which is taught by the cited art — the art cited does not appear to describe any bulk density ranges. Therefore, it is not proper to simply conclude that a completely untaught bulk density range is obvious as a result effective variable that was optimized.

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Responding to Applicants arguments filed January 5, 2005, the Examiner stated in the Office Action mailed March 25, 2005 that, "though there isn't an explicit teaching to a bulk density range, the general conditions of the claim are disclosed. As such, it is the position of the Examiner that based on the desired end use, discovering the optimum or workable bulk density range would involve only routine skill in the art." Applicants respectfully submit that this argument is improper in the face of the above-quoted clear statement in M.P.E.P. 2144.05(II)(B) (citing *In re Antonie*), which Applicants believe contradicts the Examiner's stated position.

Second, regarding the element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas, the Examiner has stated that Midkiff et al. teach using various patterned calender rolls to produce patterned bonded areas which disclose the Applicants' claims (Midkiff et al. at Column 5, lines 1-37). However, the bonding taught by Midkiff et al. is thermal point bonding, which produces discrete bond points, also called "spot bonding" as stated in Midkiff et al. However, the Applicants' claims require that there be continuous bonded area (not point) that defines a plurality of discrete unbonded areas. As described in the Application specification at page 9 line 25 through page 10 line 8, this pattern unbonded or interchangeably point unbonded (again, not "point bonded") bond pattern is quite different and distinct from the point bonding described in Midkiff et al. In the point bonding of Midkiff et al., the web is bonded at points. As described in the application specification, instead of having the discrete bonded areas or points (as in thermal point bonding) that are surrounded by unbonded areas, instead there are discrete unbonded areas which are encircled, or surrounded, by the continuous bonded area and the bonded area is not a discrete (separated) point. By way of illustration, in pattern unbonding the unbonded areas may be thought of as similar to islands encircled or surrounded by water (bonded area) which defines the perimeter of the unbonded area (island). In contrast and using the same illustration, in thermal point bonding as described in Midkiff et al., the unbonded areas would be the water surrounding the discrete bonded island points. For this reason, the combination of Drew with Midkiff et al. does not teach the claim element of bonding in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas.

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Responding to Applicants' similar arguments filed January 5, 2005, the Examiner stated in the Office Action mailed March 25, 2005 that Applicants' claims do not provide encircled or surrounded limitations and stated that it would be improper to import such limitations from the specification. However, Applicants respectfully submit that this is not a matter of importation but rather of definition of the described bonding. In the Application specification at page 9 line 25 through page 10 line 8 it is stated that this is the definition for pattern unbonded (or interchangeably point unbonded) bond patterns and Applicants' claim term "bonded in a pattern having continuous bonded areas defining a plurality of discrete unbonded areas" is how this pattern unbonded or point unbonded bond pattern is defined. In any event, and in order to clarify this matter, the Applicants have amended claim 17 to "bonded in a pattern unbonded bond pattern having continuous bonded areas defining a plurality of discrete unbonded areas".

Applicants believe the dependent claims 18-28 and 30-44, which depend either directly or indirectly from independent claim 17, recite the present invention in varying scope and further define the invention. Applicants have herein discussed the cited references in relation to independent claim 17. Claims 18-28 and 30-44 are similarly distinguishable not only because of the patentability of the independent claim but also because of the combination of the subject matter of each of the dependent claims with the independent claim which makes each claim further distinguishable.

Because there has been shown no proper motivation to combine the cited references, or, alternatively, even if Drew and Midkiff et al. are combined, the combination still fails to disclose at least two of the parameters required by Applicants' claims, Applicants again submit that a *prima facie* case of obviousness has not been set forth. For these reasons, Applicants submit that the rejection claims 17-28 and 30-44 under 35 U.S.C. §103(a) over Drew in view of Midkiff et al. should be withdrawn, and it is respectfully submitted that all of the presently presented claims are in form for allowance.

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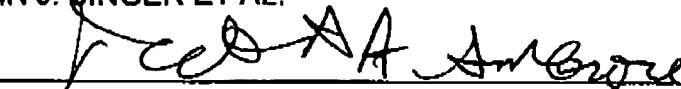
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Respectfully submitted,

IRWIN J. SINGER ET AL.

By



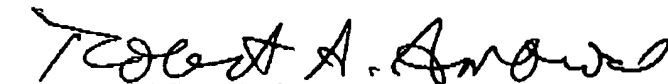
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